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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,865

02/18/2004

John A. Lawton

4676-7

6209

23117

7590

09/28/2007

NIXON & VANDERHYE, PC

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ARLINGTON, VA 22203

EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1752

MAIL DATE

DELIVERY MODE

09/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/779,865

Applicant(s)

LAWTON ET AL.

Examiner

Cynthia Hamilton

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on MARCH 30, 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: SEE ATTACHMENT. (See 37 CFR 1.116 and 41.33(a)).

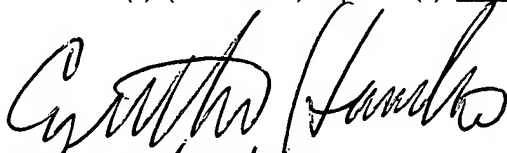
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-3, 5-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: SEE ATTACHMENT.

  
8/23/07

Cynthia Hamilton  
Primary Examiner  
Art Unit: 1752

ATTACHMENT

With respect to 3, NOTE: Applicants have added nineteen new claims and cancelled no claims in their proposed amendments. Applicants have changed the range of component (c) from 0 to 40% by weight of an hydroxy containing material to 5-40% of an hydroxy containing material in all claims. This is a new issue with respect to the claims present at final rejection. In claims 1-3 and 5-20, applicants have reduced the size of the Markush group of hydroxy containing materials to exclude the "aliphatic polycarbonate diol" yet still presented this group in new claims 21-39, thus not reducing the issues set forth in the final rejection. Thus, the amendment will not be entered because new issues are presented which would require further consideration, and raise the issue of new matter as well as clearly present additional claims without canceling a corresponding number of finally rejected claims.

With respect to 13, OTHER: The examiner notes for the record that SN 09/538,940 with respect to the photosensitive compositions does not support the upper limit of 2.5 with respect to ratio of epoxy equivalents to hydroxy equivalents in the composition, nor does there appear to be support for the 5% by weight of hydroxyl containing material. Thus, none of the newly presented claims finds sufficient support in SN 09/538,940 to set the effective filing date of any of the claims to that of SN 09/538,940 and thus remove Lawton WO 00/03300 as a reference. If applicants wish to maintain their limits to ratio of epoxy equivalents to hydroxy equivalents in the composition then the only support for such which could possibly establish an effective filing date for this application sufficiently early to remove Lawton WO 00/03300 as a reference under 35 USC 102 (b) would be SN 09/113,271 and as stated in the interview of March 14, 2007, the examiner

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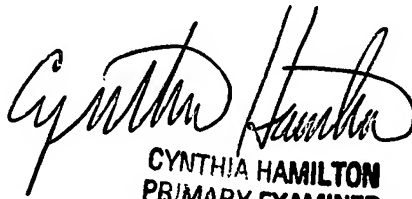
could find no support for the "aliphatic polycarbonate diol" now present in the newly claims 21-39 and present in the finally rejected claims.

The examiner notes that the Petition Decision of July 6, 2007 which is to dismiss the petition filed September 18, 2006 in view of granting the Petition filed April 4, 2006. This has been fully considered with respect to this Advisory.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.*

*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.*

  
CYNTHIA HAMILTON  
PRIMARY EXAMINER

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

~~April 9, 2007~~

8/23/07 <sup>94</sup> August 23, 2007